

4-22-98  
SJ granted

**THIS DISPOSITION  
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OF THE T.T.A.B.**

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

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APR 22 1998

PAT & TM OFFICE

Opposition No. 99,165

Saramar Corporation

v.

Koko Body Wear

Before Hohein, Hairston and Walters, Administrative  
Trademark Judges.

By the Board:

Opposer filed an opposition to the registration sought by applicant in its intent-to-use application for the mark REFLEXTIONS for "adult and childrens's dancewear; namely, leotards, bodysuits, unitards and leggings".<sup>1</sup> Opposer alleges ownership of registrations for the mark SILK REFLECTIONS for pantyhose and hosiery<sup>2</sup> and the likelihood of confusion with applicant's use of its mark on closely related goods.

Opposer filed, on December 20, 1996, a motion for summary judgment, on the basis of applicant's admissions during discovery. Opposer contends that applicant's failure

<sup>1</sup> Serial No. 74/555,633, filed August 1, 1994.

<sup>2</sup> Reg. No. 1,468,389 for the mark SILK REFLECTIONS for pantyhose, issued December 8, 1987; Reg. No. 1,587,949 for the mark SILK REFLECTIONS for hosiery, including pantyhose and knee-highs, issued March 20, 1990.

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to respond whatsoever to opposer's discovery requests by the time of the filing of the motion for summary judgment, and in particular to respond to opposer's requests for admissions, should result in the entry of judgment in opposer's favor. Opposer maintains that the requests for admission should be deemed admitted and, thus, it has been conclusively established, inter alia, that opposer is the owner of the pleaded registrations and that they are valid and subsisting, that applicant's goods are identical or closely related to opposer's goods; and that applicant's mark is similar to opposer's mark and is likely to be confused therewith, when applied to goods traditionally associated with opposer's goods. Opposer has submitted by means of the declaration of counsel for opposer, Jeffrey McFadden, copies of the discovery requests, including the requests for admission. Counsel also states therein that the time for applicant to respond to opposer's interrogatories and production requests had been extended until December 10, 1996, but responses had not been received as of the date of the filing of the motion for summary judgment and that the requests for admission were served October 21, 1996 and had never been responded to.<sup>2</sup>

As an alternative to the entry of summary judgment, opposer has requested that applicant be compelled to respond to the outstanding discovery requests without objection and that the discovery period be reopened for the limited purpose of allowing opposer follow-up discovery. In view of our disposition of the

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Applicant, in a paper dated February 1, 1997 by certificate of mailing, has filed its opposition to the motion for summary judgment, supported by the declaration of counsel Amelia Vetrone and accompanying exhibits. Applicant states that although its discovery responses had not been served by the time of the filing of the motion for summary judgment, the responses have now been served. Applicant goes on to rely upon several of these responses to support its arguments that it distributes its goods exclusively as a wholesaler to dancewear specialty shops, as opposed to opposer's direct marketing to the public, and that applicant's mark, as used, emphasizes the "X" which is intended to resemble two dancers and thus is not similar to opposer's mark, as used. Applicant contends that genuine issues of material fact exist and opposer is not entitled to summary judgment.

As for the late service of the discovery responses, counsel Vetrone states in her declaration that in early October 1996 she found it necessary to turn this case over to Lawrence Haile of the firm of Haile & Simon because of other business obligations; that on December 6, 1996, counsel Vetrone spoke with Mr. Haile and he stated that the discovery responses were completed and would be mailed that day; that on December 30, 1996 counsel Vetrone received the motion for summary judgment, no consideration need be given to this alternative

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motion for summary judgment and attempted to contact Mr. Haile but he was out of town for the holidays; that on January 10, 1997, counsel Vetrone learned that Mr. Haile had been injured in a skiing accident but that he was now back at work and would be mailing the discovery responses; that the responses were served January 16, 1997; that counsel Vitrone then learned that Mr. Haile had become behind in his casework and so on January 30, 1997 counsel Vitone prepared the opposition to the motion for summary judgment.

Opposer, on July 17, 1997, filed a reply to applicant's opposition to the motion for summary judgment. While it is true that the Trademark Rules set no specific period within which a reply must be filed, we find the passage of over five months from service of applicant's opposition much too great a period of time to permit the acceptance of a reply. Accordingly, no consideration has been given to the reply. See TBMP § 502.03.

Turning next to applicant's response to the motion for summary judgment, we note that this paper was also not timely filed. Opposer's motion for summary judgment was served on counsel for applicant on December 20, 1996. Thus, the response was due January 9, 1997. But the response was not filed until February 1, 1997 and the discovery responses, if considered a response to the motion, were not served until January 16, 1997. Thus, only if applicant has

established the requisite excusable neglect to reopen the period for response to the motion for summary judgment can either responses of applicant be taken into consideration.

In *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997), the Board set forth the applicable factors in determining excusable neglect, in view of the Supreme Court's holdings in *Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993). These factors are (1) the danger of prejudice to the non-moving party, (2) the length of the delay and its potential impact on the proceeding, (3) the reason for the delay, including whether it was within the reasonable control of the moving party, and (4) whether the moving party acted in good faith.

Here we find the third factor, namely, the reason for the delay, including whether it was within the reasonable control of applicant, to be controlling.<sup>4</sup> By an agreed extension the discovery responses were due December 10, 1996, although it is not clear whether this extension even covered the requests for admission. Applicant was obviously aware of this due date, as Mr. Haile is said to have had the responses completed by December 6, 1996. Nonetheless, the responses were not served until January 16, 1997, twenty-seven days after the motion for summary judgment had been

<sup>4</sup> As noted in the *Pumpkin* case, the third factor has in many instances been found to be the most important of the factors

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served. Although from the declaration of counsel Vetrone we know that Mr. Haile had a skiing accident sometime between December 6, 1996 and January 10, 1997, it is completely unclear as to the exact date of the accident or the period of time that Mr. Haile was out of his office. Moreover, if the responses had been completed, the mailing of the same to opposer could reasonably have been accomplished by a secretary or another member of the law firm. Furthermore, since an associate power for Mr. Haile was not filed in this proceeding until February 2, 1997, Amelia Vetrone was the sole counsel of record during the period in question and thus the responsibility for timely service of the discovery responses rested with her, as did the responsibility for responding to the motion for summary judgment. The neglect of Mr. Haile becomes the neglect of counsel Vetrone, with no valid reason having been presented for the failure of counsel Vetrone to take action to assure that these deadlines would be met.

Accordingly, we find that the failure of applicant to timely serve its discovery responses and to timely respond to the motion for summary judgment was wholly within applicant's reasonable control and applicant has failed to establish the requisite excusable neglect to reopen the time such that either the discovery responses or the opposition to opposer's motion may be considered timely served.

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As a result, opposer's motion for summary judgment may be treated as conceded. Trademark Rule 2.127(a). Or, opposer's requests for admission may be deemed admitted and the resultant admissions considered as evidence in support of opposer's motion. While reliance upon admissions obtained as a result of failure to timely respond to requests for admission may appear harsh, applicant has made no attempt to obtain the relief potentially available under FRCP 36(b), i.e, a motion to amend the admissions, and thus has established no right to have this case determined on the merits. Cf. *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990) (Motion to amend granted in connection with motion for summary judgment).

Moreover, if all of the admissions were directed to the ultimate conclusion of likelihood of confusion, then the admissions could not justifiably be relied upon by opposer to prove its case. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978) (Legal conclusions cannot be admitted, only facts can be admitted). But here applicant has admitted the following determinative facts:

- (1) Opposer is the owner of its pleaded registrations for the mark SILK REFLECTIONS and the "marks" [registrations] are valid and subsisting;
- (2) The goods in applicant's application are identical to or closely related to the products in opposer's registrations,
- (3) Applicant's proposed mark REFLEXTIONS is similar to opposer's marks; and

- (4) Goods bearing applicant's mark are sold at the retail level to consumers who are also purchasers of goods sold under opposer's marks.

In a motion for summary judgment, the burden is on the moving party to establish the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. FRCP 56(c). By means of the admissions set forth above, opposer has adequately established that no genuine issues of material fact remain with respect to either its priority<sup>5</sup> or the likelihood of confusion. Moreover, on the basis of the facts established thereby, we find that opposer is entitled to the entry of judgment in its favor.

Furthermore, even if we were to consider the arguments and exhibits submitted by applicant in its opposition to the motion, we find that applicant has failed to raise any genuine issues of material fact. Although applicant may argue that its mark is not similar to opposer's mark, taking into consideration the manner of use of the two marks, the mark sought to be registered in applicant's application is REFLECTIONS in typed form, not the specific stylized form shown on its hang tag, and it is this typed drawing which must be compared to opposer's mark, which is registered in typed form. See *Cities Service Co. v. WMF of America, Inc.*,

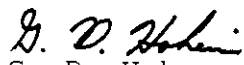
<sup>5</sup> Priority is not at issue when opposer has established ownership of its pleaded registrations and that they are valid and subsisting. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).




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199 USPQ 493 (TTAB 1978). Similarly, while applicant may contend that it manufactures and distributes its dancewear solely as a wholesaler, whereas opposer markets its hosiery directly to the public, there is no such restriction in applicant's application. Thus, the goods of the parties must be compared on the basis of the identification of the goods in the application and registrations, all of which encompass all normal channels of trade for these goods, including both the wholesale and retail levels. See *Matsushita Electric Industrial Co., Ltd v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973).

In view of the foregoing, opposer's motion for summary judgment is granted. The opposition is sustained and registration is refused to applicant.

  
G. D. Hohein

  
P. T. Hairston

  
C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board